



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,219	09/10/2003	Andre Jeutter	2001P17947WOUS	5692

7590 11/06/2007
SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPT.
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

WONG, EDNA

ART UNIT	PAPER NUMBER
----------	--------------

1795

MAIL DATE	DELIVERY MODE
-----------	---------------

11/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/659,219	Applicant(s) JEUTTER ET AL.	
	Examiner Edna Wong	Art Unit 1795	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

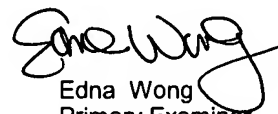
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,4-14 and 16-18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See page 2-6.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Edna Wong
Primary Examiner
Art Unit: 1795

ADVISORY ACTION

This is in response to the Amendment After Final dated October 31, 2007. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 112

I. Claims **1-2, 4-14 and 16-18** have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection of claims 1-2, 4-14 and 16-18 under 35 U.S.C. 112, first paragraph, is as applied in the Office Action dated August 9, 2007 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that the specification and Figures 1 a-d provide sufficient support for the above identified claim limitation.

In response, the Examiner maintains that there is sufficient written description for homogenization of the element distribution as mentioned on page 2, lines 19-20; and homogenization in the near-surface region, the layer being fused, for example at and/or under the surface, as mentioned on page 5, lines 1-2, but that these descriptions have

to do with the coating layer **13** and nothing to do with the substrate **1**.

The terms and phrase used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (MPEP § 2163.02 and § 2181(IV)). There are no negative recitations disclosed in the written description, and the mere absence of a positive recitation is not a basis for an exclusion.

Applicants state that the substrate is represented identically in all of Figures 1 a-d thereby indicating that "melting and homogenizing a region of the substrate located laterally adjacent the melted and homogenized substrate region" has not occurred.

In response, the structure disclosed in the specification is a "corresponding" structure in the claims only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim (MPEP § 2163.02 and § 2181(IV)). The presented negative limitation of "without homogenizing a region of the substrate located laterally adjacent the homogenized region" is not said, in the written description, to have been shown or not shown in any of the Figures.

Applicants' original method claims were open to include the step of homogenizing a region of the substrate located laterally adjacent the homogenized region. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps (MPEP § 2111.03). Thus, the showing in

Figures 1 a-d, may or may not, show every aspect of Applicants' method, for example, the Figures do not show the scanning of the surface treatment equipment 19 over the near-surface region of the coating layer as presented in claim 16.

Applicants state that since the Examiner has failed to provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the above identified inventive concepts and also has not shown why such skilled artisan would need to resort to undue experimentation to make and use the claimed invention, the Examiner has failed to meet the requirements of MPEP § 2163.04.

In response, a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the above identified inventive concepts because it was not until Applicants claims were rejected over JP 1-100302 that the negative limitation was presented. The negative limitation was not presented in any of the original claims, is not literally disclosed in Applicants' written description, and Applicants' figures do not show every aspect of the method claimed. The method is open-ended and does not exclude additional, unrecited elements or method steps.

A skilled artisan would need to resort to undue experimentation to make and use the claimed invention because "fusing" is broadly recited in Applicants' specification. Applicants' specification does not negate fusing the coating layer and the substrate,

where this would have also improved adhesion of the coating to the substrate.

II. Claim 13 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claim 13 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicants' amendment.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

Claims 1-2, 4-12 and 16-18 define over the prior art of record because the prior art does not teach or suggest a method for coating a substrate having at least one hole, comprising the steps of covering, applying and irradiating as presently claimed, esp., the step of irradiating a near-surface region of the coating layer to improve adhesion of the coating layer to the substrate, and to ensure homogenization of the coating layer without homogenizing a region of the substrate located laterally adjacent the homogenized region.

Claim 13 defines over the prior art of record because the prior art does not teach or suggest a method for coating a turbine component having at least one hole, comprising the steps of covering, applying and irradiating as presently claimed, esp.,

the step of irradiating a near-surface region of the coating layer to improve adhesion of the coating layer to the surface of the component, and to ensure homogenization of the coating layer and without homogenizing a region of the surface of the turbine component located laterally adjacent the homogenized region.

Claim 14 defines over the prior art of record because the prior art does not teach or suggest a method for recoating a substrate, which has already been used and having at least one hole, comprising the steps of covering, applying and irradiating as presently claimed, esp., the step of irradiating a near-surface region of the coating layer to improve adhesion of the coating layer to the substrate, and to ensure homogenization of the coating layer and without homogenizing a region of the substrate located laterally adjacent the homogenized region.

The prior art does not contain any language that teaches or suggests the above. *JP 1-100302* does not teach without homogenizing a region of the component located laterally adjacent the homogenized region. *JP 1-100302* teaches that both the hard substance and blade mother metal are melted and fused on the surface of the blade. Therefore, a person skilled in the art would not have been motivated to adopt the above conditions, and a prima facie case of obviousness cannot be established.

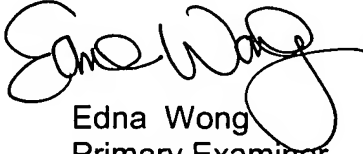
Claims 1-2, 4-14 and 16-18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Art Unit: 1795

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number (571) 272-1349. The examiner normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Edna Wong
Primary Examiner
Art Unit 1795

EW
November 3, 2007